

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD B. ALLEN

Appeal No. 97-0925
Application No. 08/328,159¹

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 5 through 9, 11 and 13 through 16, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed October 24, 1994. According to the appellant, the application is a continuation of Application No. 08/066,788, filed May 24, 1993.

BACKGROUND

The appellant's invention relates to an umbrella for use in a stadium. An understanding of the invention can be derived from a reading of exemplary claims 1 and 9, which appear in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) and obviousness under 35 U.S.C. § 103 is:

Rowsey, Jr.
(Rowsey)

4,271,604

June 9, 1981

Claims 1, 3, 5 through 9, 11 and 13 through 16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

Claims 1, 3, 5 through 9, 11 and 13 through 16 stand rejected under 35 U.S.C. § 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rowsey.

Claims 1, 5, 9 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rowsey.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 10, mailed April 24, 1996) and the examiner's answer (Paper No. 13, mailed October 21, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed September 23, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The enablement issue

We will not sustain the examiner's rejection of claims 1, 3, 5 through 9, 11 and 13 through 16 under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done. In fact, the examiner has only pointed to claim language that is unclear in the examiner's opinion. If the language of a claim is unclear,

the rejection of such a claim lies under the second paragraph of 35 U.S.C. § 112, not the first paragraph thereof. Accordingly, we will treat the basis for this rejection as having been made under the second paragraph of 35 U.S.C. § 112 in the next section of this decision. Since the examiner has not advanced any reasoning inconsistent with enablement, we reverse the examiner's rejection of claims 1, 3, 5 through 9, 11 and 13 through 16 under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

The indefiniteness issue

We will not sustain the examiner's rejection of claims 1, 3, 5 through 9, 11 and 13 through 16 under 35 U.S.C. § 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this

determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

The examiner's bases for this rejection are: (1) In claim 1, it is unclear what constitutes the edge of the ribs or the cover or the cylindrical portion; (2) In claim 9, it is unclear what

the combined vertical dimension of the cover is; (3) In claim 1, the term "said cylindrical portion" lacks antecedent basis; (4) In claim 1, it is unclear to which preceding term (e.g., ribs, cover, cylindrical portion) the term "which" refers back to; (5) In claim 1, the phrase "the edge of which is parallel to the axis of the center pole" is unclear as to where the edge is being located and which element's edge is being recited; and (6) In claim 9, there is no antecedent basis for "the combined vertical dimension of the umbrella."

For the reasons set forth by the appellant (brief, pp. 7-11), we conclude that the claims are definite since the scope of the claims would be reasonably ascertainable by those skilled in the art. Since the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, the examiner's rejection of claims 1, 3, 5 through 9, 11 and 13 through 16 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation issue

We will not sustain the examiner's rejection of claims 1 and 9 under 35 U.S.C. § 102(b) as being anticipated by Rowsey.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 is directed to an umbrella whose cover in the open mode assumes a cylindrical shape with a hemispherically shaped top. Claim 9 is directed to an umbrella which, when in the open mode, assumes a shape wherein the lowermost portion is cylindrical and the uppermost portion is hemispherical or dome-shaped.

Rowsey discloses a portable planetarium having the shape, structure, and utility of an extended umbrella while serving the dual and more important function of being an educational tool usable to ascertain the location of planets and stars throughout the year. The planetarium includes a frame having a configuration defined by a frustrum of a cone with a substantially hemispherical cap attached thereon. A pole is aligned with the center axis of the frustrum of the cone and extends through the top of the hemispherical cap, with the

intersection of the pole and the top of the hemispherical cap utilized as a reference point denoting the north star or Polaris. A covering is secured to the frame and a plurality of markings are selectively applied to the covering using Polaris as the reference point.

For the reasons set forth by the appellant (brief, pp. 4-6 and 14-17), we conclude that claims 1 and 9 are not anticipated by Rowsey. We agree with the appellant that the claimed configuration (i.e., a cylindrical shape with a hemispherically or dome shaped top) does not "read on"² Rowsey's configuration (i.e., a frustrum of a cone shape with a hemispherically or dome shaped top). Since each element of claims 1 and 9 is not found, either expressly described or under principles of inherency, in Rowsey, the examiner's rejection of claims 1 and 9 under 35 U.S.C. § 102(b) is reversed.

² The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The obviousness issue

We will not sustain the examiner's rejection of claims 1, 5, 9 and 13 under 35 U.S.C. § 103 as being unpatentable over Rowsey.

Obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re

Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The examiner in the rejection of claims 1, 5, 9 and 13 under 35 U.S.C. § 103 determined (final rejection, pp. 3-4) that

it would have been obvious to one skilled in the art to modify Rowsey's canopy by forming the canopy into a cylindrical shape.

For the reasons set forth by the appellant (brief, pp. 11-17), we conclude that claims 1, 5, 9 and 13 are not obvious over Rowsey. It is our view, after a careful review of the teachings of Rowsey, that in searching for an incentive for modifying the shape of the planetarium/umbrella of Rowsey, the examiner has impermissibly drawn from the appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Since we have determined that the subject matter of independent claims 1 and 9 would not have been suggested by the teachings of the applied prior art, it follows that we will not sustain the

examiner's rejection of appealed independent claims 1 and 9, or
claims 5 and 13 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 5 through 9, 11 and 13 through 16 under 35 U.S.C. § 112, first and second paragraphs, is reversed; the decision of the examiner to reject claims 1 and 9 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 1, 5, 9 and 13 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPLICATION NO. 08/328,159

APJ NASE

APJ ABRAMS

APJ CALVERT

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 04 May 98

FINAL TYPED: